

## **REMARKS**

By this Amendment, Applicants amend the title and claims 1, 2, 4-6, 8-12, 14-17, 19, and 20 to more appropriately define the present invention, and add new claims 21-26 to protect additional aspects of Applicants' invention. No new matter is introduced. Claims 1-6, 8-12, 14-17, 19, and 20-26 are thus currently pending.

In the last Office Action, the Examiner objected to the title for allegedly being duplicative of the titles in Application Nos. 09/821,638 and 09/537,849. Further, the Examiner rejected claims 1-6, 8-12, 14-17, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,006,161 to Katou (hereinafter "Katou") and further in view of U.S. Patent No. 5,428,546 to Shah et al. (hereinafter "Shah").

Applicants respectfully traverse for the following reasons.

### **I. OBJECTIONS TO THE SPECIFICATION**

To expedite prosecution, Applicants have amended the title. Accordingly, Applicants request that the Examiner withdraw the objection to the title.

### **II. REJECTION UNDER 35 U.S.C. §103(a)**

To establish a prima facie case of obviousness, each of three requirements must be met. First, the cited references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. § 2143.03 (8th ed. 2001)). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. See *id.* Third, a reasonable expectation of success must exist. See *id.* Moreover, each of the these

requirements must “be found in the prior art, and not based on applicant’s disclosure.” (M.P.E.P. § 2143 (8th ed. 2001)).

Applicant’s claim 1 recites a “method of georeferencing a raster map,” the method including, among other things, “receiving pixel coordinates for the first point on the first map and the second point on the first map; receiving geographic coordinates for the first point on the second map and the second point on the second map; and computing a georeferencing function for the first map in accordance with a relationship between the geographic coordinates.” Katou and Shau, whether taken alone or in reasonable combination, fail to disclose or suggest at least these features.

By contrast, Katou discloses a land vehicle electronic navigation system. For example, the navigation system is embedded in the dashboard of a vehicle. See Katou, col. 4, ll. 35-36. The navigation system provides detection of the location of the vehicle and displays its location to an operator of the vehicle. This enables the vehicle’s operator to “view and verify his or her vehicle’s present location and acquire necessary information concerning a route along which the vehicle is to travel.” Therefore, the purpose of Katou is to display information to the operator of a vehicle, not to “georeference a raster map.” Thus, Katou does not teach or suggest, at least, the claimed steps of “receiving pixel coordinates for the first point on the first map and the second point on the first map; receiving geographic coordinates for the first point on the second map and the second point on the second map; and computing a georeferencing function for the first map in accordance with a relationship between the geographic coordinates,” as recited in Applicants’ claim 1.

Shah does not overcome the deficiencies of Katou. Shah is directed to a method and system for “simultaneously displaying a raster map and vectorized street information. The system extracts information from a plurality of databases, including a mobile position database, a raster database, and a vector database. The database information is interrelated by common latitude and longitude information. A graphical user interface displays the information in a format easily understood to a dispatcher.” Shah, Abstract. Thus, Shah merely discloses displaying information from a variety of sources or databases to, for example, a dispatcher overseeing a fleet of vehicles. Having the plurality of sources of information, the dispatcher may have more information in order to determine the location of a vehicle and relative position to other location. However, Shah does not disclose a method or system for “georeferencing a raster map.” In fact, Shah discloses that the databases and maps already exist and the purpose of Shah’s disclosure is to take the variety of sources of information and display it to a dispatcher. Therefore, Shah, like Katou, does not teach or suggest each and every element of claim 1, including at least, “receiving pixel coordinates for the first point on the first map and the second point on the first map; receiving geographic coordinates for the first point on the second map and the second point on the second map; and computing a georeferencing function for the first map in accordance with a relationship between the geographic coordinates,” as recited in Applicants’ claim 1.

The Examiner alleges “it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the teaching of Shah into Katou.” Office Action, pg. 4. “The implementation would have less cost and provides enough information to overcome the result of Applicant’s invention.” *Id.* Applicants respectfully

disagree with the Examiner's allegations and conclusions as an unsubstantiated statement of questionable relevance to Applicants' claimed invention. Both Katou and Shah only focus on the display of information to a user, such as a driver in Katou and a dispatcher in Shah. The combination of Katou and Shah would not result in the Applicants' invention as recited in claim 1, which recites, for example, "receiving pixel coordinates for the first point on the first map and the second point on the first map; receiving geographic coordinates for the first point on the second map and the second point on the second map; and computing a georeferencing function for the first map in accordance with a relationship between the geographic coordinates."

Further, the Examiner has not provided any motivation to combine the cited references nor any reasonable likelihood of success from doing so. Therefore, the rejection to claim 1 fails for these additional reasons as well.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection to claim 1. In addition, based at least on their dependence upon allowable independent claim 1, Applicants respectfully request the Examiner to withdraw the rejection to claims 2-6 and 8-10.

Further, for the reasons set forth for the allowability of claim 1, independent claims 11 and 16 also are allowable. Specifically, Katou in view of Shah, fail to disclose at least the claimed "receiving pixel coordinates for the first point on the first map and the second point on the first map; receiving geographic coordinates for the first point on the second map and the second point on the second map; and computing a georeferencing function for the first map in accordance with a relationship between the geographic coordinates." Because claims 11 and 16, although of different scope,

contain similar claim recitations as those in claim 1, Katou in view of Shah fail to disclose each and every element of claims 11 and 16. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claim 11 and 16, as well as that of claims 12, 14, 15, 17, 19, and 20 based, at least, upon their respective dependence upon allowable independent claims 11 and 16.

New claims 21-24 depend from allowable independent claims 1, 11, and 16, and are allowable for at least the reasons discussed above in connection with allowable independent claims 1, 11, and 16. Applicants respectfully request the Examiner to allow new claims 21-23.

Additionally, new claim 25 recites a combination including, among other things, "receiving a finite sequence of two or more point-pairs, each point-pair consisting of a point from the first map and a corresponding point from the second map, wherein the point-pairs are chosen such that corresponding points of each point-pair refer to the same geographic location; and computing, with each additional point-pair received after the first point-pair, a georeferencing function for the first map that expresses a mathematical relationship between pixel coordinates and geographic coordinates of an arbitrary point on the first map." The steps recited in Claim 25 are neither disclosed nor suggested by the cited prior art for at least the same reasons discussed above in relation to independent claim 1, 11, and 16. Claim 26 depends from claim 25. Accordingly, Applicants respectfully request the Examiner to allow new claims 25-26.

### **CONCLUSION**

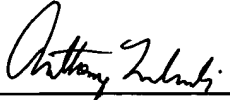
In view of the foregoing remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: April 8, 2004

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